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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,659	12/17/2001	Hisashi Shoda	217360US0CONT	8520

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EXAMINER
ANGÉBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,659

Applicant(s)

SHODA ET AL.

Examiner

Martin J Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/17/01, 3/1/01, 3/6/01, 4/29/03, 8/13/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3, & 6.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The amendment filed 12/17/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The use of square brackets is improper (in both the specification when filed and in the amendment) and the limitation of the dialkylamino group to 2-12 carbon atoms is improper.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "the residual moiety " lacks antecedent basis. It is not clear what the applicant intends.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being fully anticipated by JP 04-308791.

In comparative example 4, azo dyes 1 and 5 which are different in structure are in solution together with 3-hydroxy-3-methyl-butanone (HMB) as the solvent and then coated. The examiner holds that exchange of the ligands occurs as these are ionic bonds to the central metals and at least some of the metal chelate dyes in the coated optical recording layer have different ligands attached to the same central metal as required by the claims.

With respect to claim 4, the full scope is read as more than one molecule.

8. Claims 1-7 are rejected under 35 U.S.C. 102(a) as being fully anticipated by Tosaki et al. WO 00/55136. (English equivalent is Tosaki et al. '682)

See examples 1-27 in table 1 and 2 (pages 32), these compounds illustrated on pages 33-44 and the results using these compounds in optical recording media in table 3 on pages 46-47.

9. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Tosaki et al. '682.

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See examples 1-27 in tables 1 and 2 (column 25), these compounds illustrated in columns 25-3 and the results using these compounds in optical recording media in table 3 in columns 33-34. The examiner notes that the claims are similar to those of the instant application.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambe et al. EP 0887202.

Kambe et al. EP 0887202 disclosed mixed ligand systems with respect to dyes C-3 and C-4 on page 24 and C-29 on page 27. Sample 239, discloses that recording layers using dye C-29 have high reflectance, and modulation with low jitter and recording power relative to other compounds disclosed with ligands which are the same. (page 60). Examples 5 discloses that dyes C-3 and C4 function well. (62/36-41). Compounds C-26, and D-15 through D-20 use heterocyclic moieties and were used in examples 1 (58/9-28) and sample 236 (page 59). The disclosure of azo compounds bounded by formula (III) (page 4) where A is either an aromatic moiety with a pendant group bearing an active hydrogen or a nitrogen containing heteroaromatic moiety and B is an aromatic moiety with a pendant group bearing an active hydrogen. (24/35-43). Examples of A include pyridine, thiazole, benzothiazole, oxazole, benzoxazole, quinoline, pyrazine, and pyrrole rings. Active hydrogen containing groups are also disclosed. (7/25-31). The specific disclosure that the ligands may be the same or different is made. (8/15-16)

It would have been obvious to one skilled in the art to modify the invention of examples 5 and 239 of Kambe et al. EP 0887202 by using mixed ligand systems which contain heterocyclic moieties rather than aromatic moieties with a pendant group bearing an active hydrogen based upon the disclosure of the use of mixed ligands and the use of heterocyclic moieties in place of aromatic moieties with a pendant group bearing an active hydrogen in

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Kambe et al. EP 0887202 and/or it would have been obvious to one skilled in the art to modify the invention of examples 1 and 236 of Kambe et al. EP 0887202 by using mixed ligand systems, rather than single type of ligands, which contain heterocyclic moieties based upon the disclosure of the use of mixed ligands.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maeda et al. JP 04-361088 teaches one, two or more azo compounds with a central metal (abstract), but does not appear to exemplify this.

Ueno et al. JP 10-006651 (machine translation attached) teaches mixed ligand chelating systems for azo dyes. See compounds 7, 16 and 23. These do not have the requisite heterocyclic moieties.

Bailey et al. '527 teach mixed ligand systems in photographic materials.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannt whose telephone number is 703-308-4397. The examiner can normally be reached on Mondays-Thursday and alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Martin J Angebrannt
Primary Examiner
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August 15, 2003